



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,852	02/19/2002	Jeremy Marshall	3003-1004	2432
466	7590	05/17/2004		
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER WEBB, SARAH K	
			ART UNIT	PAPER NUMBER

3731

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/049,852

**Applicant(s)**

MARSHALL ET AL.

**Examiner**

Sarah K Webb

**Art Unit**

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8,9 and 18 is/are rejected.
- 7) ☐ Claim(s) 3,4,6,7,10-17,19, and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/19/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on 08/19/1999. It is noted, however, that applicant has not filed a certified copy of the 9919681.8 application as required by 35 U.S.C. 119(b).

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: applicant should remove the commas in line 10 since they are not necessary. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5, 8, 9, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,871,494 (Simons et al.) in view of US Patent No. 5,569,189 (Parsons).

The devices of Simons and Parsons are similar in that they both include spring driven mechanisms for piercing the skin. The Simons device drives a lancet into the skin, while the Parsons device drives liquid into the skin. Since both devices are

Art Unit: 3731

adapted for skin piercing and the structures of the driving mechanisms are very similar, they are considered to be of analogous art.

Simons discloses a skin piercing device in Figures 5A and 5B that includes a barrel (526), lancet carrying means (210) at the forward part of the barrel, and a hammer (542) that causes advance of the lancet (216). A driver spring (552) is positioned to the rear of the hammer (542) and a trigger (538) is provided for holding and releasing the hammer.

The device further includes barrier (528) that is adjusted axially by rotation. Simons explains that rotation of the barrier (528) relative to the casing (526) changes the length of compression of a spring (532) (column 12, lines 55-64).

Parsons discloses another type of skin piercing device in Figure 5 that includes a barrel (30), a hammer (28), a barrier (42) to the rear of the hammer, a spring (34) between the barrier and the hammer, and a trigger mechanism (column 10, lines 6-32) for holding and releasing the hammer. Parsons explains that rotation of the barrier (42) adjusts the axial length, or compression, of the spring (34) (column 9, lines 10-28). The spring drives the hammer, which acts on a plunger (8) to drive liquid into the skin.

Simons fails to position the adjustable barrier to the rear of the hammer, but Simons does include a structure that adjusts the compression of a spring by selectively altering the axial location of a barrier that acts to the rear of the spring. Parsons teaches that an adjustable barrier can be positioned to the rear of a hammer of a skin piercing device to alter the driving force of the hammer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to position the axially

Art Unit: 3731

adjustable barrier of Simons to the rear of the driver spring and hammer, as Parsons teaches that this particular arrangement of parts allows the driving force of the hammer to be altered.

Regarding claim 2, the outer threads of the barrier and inner threads of the barrel can be described as "*slots skew to the axis of the barrel in which projections on the barrier engage.*"

Regarding claim 5: Simons includes a sleeve (562) on the rear portion that is spring (568) urged forwardly. The sleeve retracts the hammer when pulled back and disconnects from the hammer when released to move forward (column 12, lines 16-26).

Regarding claims 8, 9, and 18: Simons includes a removable nose section (210) of the barrel (Figure 3C). A lancet carrying means (224) is tubular, spring urged rearwardly (228), and a lancet (216) fits into the forward end.

### **Conclusion**

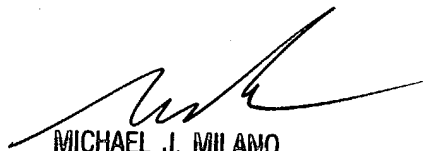
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K Webb whose telephone number is (703) 605-1176. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKW  
05/10/04



MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700